

Circuit.² *California v. Taylor*, 353 U.S. 553, 557 n.2 (1957) (refusing to consider issues not advanced to Court of Appeals).

Because Petitioner did not raise these issues of patent law to the Federal Circuit, which, accordingly, did not decide them, the questions have not been preserved for review by this Court.

II. BECAUSE THE FEDERAL CIRCUIT'S DECISION IS UNPUBLISHED, IT LACKS PRECEDENTIAL VALUE AND, THEREFORE, DOES NOT PRESENT AN IMPORTANT ISSUE OF PATENT LAW.

Petitioner complains of the Federal Circuit's resolution of its claim for patent infringement. However, the Federal Circuit disposed of this case in an unpublished decision issued under Federal Circuit Rule 47.6(b) as indicated in the upper legend on the first page of the Federal Circuit's opinion.³ See *Hartco*, 142 Fed. Appx. 455. Federal Circuit Rule 47.6(b) states that "[a]n opinion . . . which is designated as not to be cited as precedent is one unanimously determined by the panel issuing it as not adding significantly to the body of law. Any opinion . . . so designated must not be employed or cited as precedent. . . ." Whatever value the Federal Circuit's *Hartco* opinion and judgment might have to the parties to this proceeding, the opinion is of no precedential value to the patent bar or the public by operation of Federal Circuit Rule 47.6(b).

2. Petitioner also did not advance the issues in the Questions Presented to the District Court.

3. In the Petition's Appendix B (p. 3a), the Local Rule 47.6(b) legend has been omitted.

The Federal Circuit has exclusive appellate jurisdiction over decisions from district courts in patent litigation. 28 U.S.C. § 1295(a)(1). Here, by virtue of Federal Circuit Rule 47.6(b), the Federal Circuit opinion has no precedential value to patent cases in the district courts or the Federal Circuit, the only appellate court in which such a decision might be of any use. Assuming *arguendo* that the Federal Circuit erred, its error is confined to these parties. Accordingly, the Petition does not present an important issue of patent law worthy of this Court's review and consumption of its limited resources.

III. THE PETITION PRESENTS NO PERSUASIVE ARGUMENTS FOR GRANTING REVIEW.

The Petition should also be denied because it raises no genuine questions of federal law concerning the Federal Circuit's decision. The present controversy represents a limited dispute over the application of settled design patent law to a particular set of facts.

A. The Decision of the Federal Circuit Does not Conflict with Any Decision of This Court.

One basis stated in Supreme Court Rule 10(c) for grant of a Petition is that the court of appeals has decided an important question of federal law in a way that conflicts with relevant decisions of this Court. Petitioner argues that the Federal Circuit action below conflicts with this Court's holding in *Gorham Co. v. White*. This contention is unfounded.

The seminal *Gorham* case resolved a controversy over infringement of a design patent to a silver flatware pattern. Numerous experts had testified to the overall similarity of

the two accused designs to the patented design, despite differences in minute design details. Quite telling was the testimony that the designs could not be readily distinguished from short distances, or at first appearance, and that the accused design appeared to have been intended to appear the same to an ordinary purchaser, but not to a design expert. *Gorham*, 81 U.S. at 523-24. The court of appeals had held that, as with utility patents, the accused and patented designs must be compared by experts, with careful attention to minute details.

In reversing, *Gorham* established one simple proposition: the determination of design patent infringement is to be made from the perspective of an ordinary observer, such as a prospective purchaser, and not that of a design expert who examines the design carefully and applies specialized design expertise. *Gorham*, 81 U.S. at 528. The *Gorham* Court's conclusion was that substantial sameness would be established by such an ordinary observer if the observer would be induced to purchase one design thinking that it was the other design. What the *Gorham* Court did not say was "thinking that it embodied the same design concept" or "thinking that it was created by the same hand." And that is the crux of the present controversy.

In the case at bar, the Federal Circuit decision cited this Court's holding in *Gorham* as part of its determination that:

The designs do not have to be identical to an accused device to be protected, *see OddzOn*, 122 F.3d at 1405, but Hartco's patented design is limited to the design it claimed with the three blades and the four circular features. Appellants'

four-blade product has a substantially different overall ornamental appearance from the claimed three-bladed product.

Petition Appendix p. 10a.

The Federal Circuit applied the *Gorham* test to compare the ornamental features of the accused design to the '194 Patent design, and concluded that the designs were clearly distinguishable, and that no substantial evidence existed from which a reasonable jury could conclude that they were substantially the same.

1. The Federal Circuit Jurisprudence of Design Patents Follows Well-Established Patent Law.

Petitioner argues the Federal Circuit has “gutted” this Court’s holding in *Gorham* by a series of decisions over approximately two decades that allegedly narrow the formerly broad scope of design patent protection. However, it is clear that the Federal Circuit continues to apply the *Gorham* holding and has simply addressed a number of issues that arise as inevitable consequences of construing a patent having a single claim directed to the ornamental features of the depicted design.

The first case to elicit the Petitioner’s ire is *In re Mann*, 861 F.2d 1581 (Fed. Cir. 1988). In discussing design changes, the *Mann* court held that in the context of a design patent a changed design constitutes a new and different design, because the scope of a claimed design is limited to what is shown and described in the patent drawings. This holding is the inevitable consequence of construing a single claim to a

depicted design. A design patent claim cannot have broad scope because the single claim must have a definite scope as required by the patent statutes, and the scope is limited to the design as presented in the drawings. Any range of interpretation in the determination of infringement is limited to the substantially similar/ordinary observer test as articulated by *Gorham*, or the equivalent “colorable imitation” test. *Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113 (Fed. Cir. 1998).

Further, Petitioner complains of *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), which extended this Court’s ruling in *Markman* to design patents. Petitioner states that the combination of the holdings of *Elmer* and *In re Mann* has virtually eliminated the possibility of a finding of design patent infringement, reasoning:

Rather than comparing the accused product to the patented design through the eye of the ordinary observer to determine substantial sameness of the “general appearance and effect” as taught by *Gorham*, adherence to *Elmer* requires the district courts to recast the governing patent drawings into words – often long presentations – that may or may not allow the reader to accurately visualize the patented design.

Petition p.14.

It is appropriate to charge the trial court with verbally construing a design patent claim for a number of reasons. At this point, it is sufficient to say that Petitioner’s argument vastly overstates the issue. Nothing in the *Elmer* decision eliminates a comparison between the design patent

drawings and the accused design. *Elmer* explicitly incorporated *Gorham*'s "ordinary observer" test into the test for infringement of a design patent. The *Elmer* Court clearly stated that:

[T]he claim as properly construed must be compared to the accused design to determine whether there has been infringement . . . In this second step, the patented and accused designs are compared for overall visual similarity.

Elmer, 67 F.3d at 1577 [citing *Gorham*]. Thus, the *Elmer* Court did not substitute the verbal claim construction for the patent drawings in the comparison step. Rather, the verbal claim construction is provided as an aid to guide the fact-finder's differentiation between novel, ornamental (and thus protectable) features of the design and old, functional, unprotectable features. In fact, the Federal Circuit utilized the '194 Patent drawings in its considerations in the case at bar:

Under the ordinary observer test, "[o]ne must compare the ornamental features of the patented design, as shown in all of the drawings, to the features of the alleged infringing product visible at anytime during normal use of the product." *Contessa*, 282 F.3d at 1380.

Petition Appendix p. 9a.

Petitioner's conflict argument is clearly misplaced. The Federal Circuit continues to apply the *Gorham* rule, albeit with a result in this case Petitioner does not like.

2. The Federal Circuit Correctly Held That no Substantial Evidence Existed to Support a Verdict of Design Patent Infringement.

In this case, the Federal Circuit was presented with a jury verdict of design patent infringement rendered upon flawed instructions (*see infra*). The Federal Circuit applied the law as stated in *Gorham* to a set of uncontested facts, and simply held that no substantial evidence existed to support a jury verdict of design patent infringement of a properly construed claim. The court held:

We agree with the district court's depiction of the drawings of the '194 patent as showing a hitchcover "with three blades" attached to a tongue "having four circular features" that are visible. Only these ornamental aspects of Hartco's patented hitchcover design, not the broader, general hitchcover concept that merely mimics a propeller, are protected. *See OddzOn*, 122 F.3d at 1405; *see also Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 104 (Fed. Cir. 1996). Therefore, Hartco's design patent does not cover any hitchcover shaped as a propeller with any number of blades, regardless of its ornamental features. *See OddzOn*, 122 F.3d at 1400. Specifically, the inclusion of blades, a nose, and a tongue are part of the general propeller concept and not protected ornamental aspects independent of their unique configuration. *See Durling*, 101 F.3d at 104. Instead, only the number and shape of the blades, as well as the four circular features, are ornamental aspects, subject to patent protection. Hartco chose to include these features in its design application

and limited the scope of its patent claim to that design, *see Elmer*, 67 F.3d at 1577.

Following claim construction, determining patent infringement next requires comparison of the patented and accused designs overall. *Contessa Food Prods. Inc. v. Conagra, Inc.*, 282 F.3d 1370, 1376 (Fed. Cir. 2002); *Elmer*, 67 F.3d at 1577. "Comparison to the accused product includes two distinct tests, both of which must be satisfied in order to find infringement: (a) the 'ordinary observer' test, and (b) the 'point of novelty' test." *Contessa*, 282 F.3d at 1377; *Unidynamics Corp. v. Automatic Prods. Int'l, Ltd.*, 157 F.3d 1311, 1323 (Fed. Cir. 1998); *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871). The two tests are separate, with the "point of novelty" test requiring proof that the accused device infringes the novel aspects of patented design as distinct from the prior art. *Contessa*, 282 F.3d at 1377; *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984). Under the ordinary observer test, "[o]ne must compare the ornamental features of the patented design, as shown in all of the drawings, to the features of the alleged infringing product visible at anytime during normal use of the product." *Contessa*, 282 F.3d at 1380.

Comparing the two designs, we disagree with the district court that the jury verdict of design patent infringement was supported by substantial evidence. The designs do not have to be identical to an accused device to be protected, *see OddzOn*,

122 F.3d at 1405, but Hartco's patented design is limited to the design it claimed with the three-blades and four circular features. Appellants' four-blade product has a substantially different overall ornamental appearance from the claimed three-blade product. See *Elmer*, 67 F.3d at 1577-78. As no reasonable jury could have concluded that the overall visual appearance of the claimed design is substantially similar to the accused design, we do not need to employ the point of novelty test. See *KeyStone Retaining Wall Sys.*, 997 F.2d at 1451. We thus reverse the district court's denial of judgment of noninfringement as a matter of law, together with the award of damages for design patent infringement.

Petition Appendix pp. 8a - 10a.

As is apparent to everyone but Petitioner, the two designs are readily distinguishable by an ordinary observer, even upon the most casual inspection. The Federal Circuit, therefore, simply stated the obvious: no ordinary observer could mistake four blades for three, or the lack of ornamental circular features for their presence. As the Federal Circuit observed, virtually every other element in the '194 Patent design was either functional or was inherent in the propeller concept, and thus not protectable in a patent to a single ornamental design.

As both the trial court and the Federal Circuit stated, the four circular features in the tongue portion of the design are an ornamental part of the design, and they are utterly lacking in the accused device. Petitioner argues that the circular features are simply artifacts of the molding process, but it is

also clear under the law that there are no unimportant features in a claimed design. "A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design." *In re Blum*, 374 F.2d 904, 907 (C.C.P.A. 1967). The simple response to Petitioner's argument was stated by the Federal Circuit:

Hartco chose to include these features in its design application and limited the scope of its patent claim to that design, see *Elmer*, 67 F.3d at 1577.

Petition Appendix p. 9a.

Further, accepting Petitioner's argument that the circular features are not part of the protected design would negate the long-standing requirement that the patent prosecution history is used to interpret the scope of a patent claim. The patent application that resulted in the '194 Patent was originally submitted with a set of informal drawings. In the first Office Action, the Examiner suggested that formal inked drawings were desirable. When the applicant submitted a set of proposed inked drawings to replace the informal drawings, the Examiner objected to the new drawings and noted that "the four circular features located in the interior corners of the hitchcover must be enlarged to match their relative size as shown in as-filed Fig. 3." The applicant submitted new formal drawings to correct the objections, and the '194 Patent was allowed to issue. Thus, to attempt to recast these design features as mere artifacts of the production process ignores the process whereby the '194 Patent was granted.

B. The Application of *Markman v. Westview Instruments* to Design Patent Claim Construction is Necessary to Properly Instruct the Jury and to Create a Complete Record for Appellate Review.

Petitioner argues, again for the first time, that the extension of this Court's holding in *Markman v. Westview Instruments*⁴ to design patents somehow negates the holding in *Gorham* that infringement is judged on the overall appearance and effect of the patented design. As will be seen, the extension of *Markman* to design patent claim construction is an important part of properly instructing the jury in matters of law and creating a complete record to facilitate appellate review.

1. The Construction of a Claim, whether from a Utility or Design Patent, is a Matter of Law.

As articulated by the Federal Circuit and confirmed by this Court, patent claim construction is a matter of law to be decided by the courts and explained to juries to inform their deliberations and verdicts in matters of patent claim infringement. *Markman*, 517 U.S. at 391. Petitioner does not dispute this point, but instead argues that this Court's holding in *Gorham* should somehow eliminate the application of this settled law to design patent claims.

Petitioner's argument appears based on an erroneous conclusion that *Markman* requires that the jury be presented only with the verbal claim construction, and *Markman*

4. It was not this Court's *Markman* holding that was cited by the *Elmer* court, but rather the underlying Federal Circuit decision. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995).

eliminates comparison with the design patent drawings. As presented above, this argument misstates the holding in *Elmer* and does not reflect the proceedings in the case at bar, where both the trial court and the Federal Circuit employed the patent drawings and not just the verbal claim construction in their infringement determinations.

Given that it is undisputed that patent claim construction is an issue of law, there is no reason, let alone a compelling one, to preclude the courts from making design patent claim construction determinations and properly instructing juries as to claim scope and their obligations to follow the law.

2. The Trial Judge Is Required to Instruct the Jury in Matters of Law.

Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design as shown in the patent. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988).

In a charge of design patent infringement, it is the plaintiff's obligation to establish that the various features of its patented design are ornamental, rather than functional. *Elmer* 67 F.3d at 1577. Thus, as part of the trial court's obligation to instruct the jury properly in matters of law, *Sulzer Textil A.G. v. Picanol*, 358 F.3d 1356, 1363 (Fed. Cir. 2004), the trial court must articulate an overall description (construction) of the claimed design, and instruct the jury that it is obligated to compare only the ornamental features in common between the claimed design and the accused product.

Given this obligation, the promulgation of a *Markman* verbal claim construction is clearly the appropriate way for the trial court to satisfy its obligations and to ensure that the jury is not misled into thinking that a design patent protects functional aspects of the design or design concepts, rather than the single design as depicted in the drawings.

3. The Trial Court Must Compile a Complete Record in Order to Permit Appellate Review.

Furthermore, one of the tasks of a trial court is to present a complete record of the evidence presented at trial and the legal and factual issues decided, so that an appellate court will be able to respond adequately to assertions of error by aggrieved parties. In the case of design patent infringement determinations, absent a *Markman* verbal claim construction by the trial court, the record would contain nothing to guide the appellate court in reviewing the verdict, because a record of the "finding of fact" by the jury would simply consist of a statement that the two designs are or are not substantially the same in overall appearance and effect. Likewise, no record would exist of what influence the functional or conceptual features *versus* the specific ornamental design features had in informing the jury verdict.

Thus, Petitioner's argument that trial courts should not engage in verbal construction of design patent claims is tantamount to an argument that an appellate court should be given no information other than a jury verdict of infringement *vel non* upon which to base its review.

C. Reversal of a Flawed Jury Verdict Based on Lack of Substantial Evidence Does not Violate Constitutional Protections.

Petitioner further complains that the Federal Circuit's decision violates its Constitutional right to a trial by jury, apparently arguing that because a determination of infringement is an issue of fact and because designs protected by patents are simple to understand, then a jury verdict of design patent infringement should not be overturned on appeal.

Petitioner's argument is wrong on a number of grounds and is simply a further example of its efforts to create a reviewable issue out of its disappointment in losing before the Federal Circuit.

1. The Jury was not Instructed Its Verdict Must Follow the Law.

In pretrial, the trial court issued the following construction of the '194 Patent claim:

An automotive hitchcover having a propeller with three blades attached to a tongue having four circular features in the interior corners of the tongue and a fifth central circular cone feature, all visible on the end remote from the propeller.

Although the trial court made no findings in this regard, the Federal Circuit noted that the design of the '194 Patent consists of both functional elements and non-functional ornamental elements, and also includes aspects that are inherent in the broad concept of a marine propeller used as a

hitchcover. The standard shapes of trailer hitch receivers dictated the external design of the tongue portion of the hitchcover. Very few possible shapes can be adopted and still fit into these standard articles. Thus, the only features of this portion of the '194 Patent design that could be considered ornamental were the four circular features located in the interior corners of the hitchcover tongue. Similarly, the propeller portion of the design is the design concept of a marine propeller and is at least partly functional as well, for a propeller is required in order to impart the spinning motion that is a primary aspect of the use of the hitchcover. In addition, the public would recognize only a limited number of propeller configurations as marine propellers (as distinct from aircraft propellers and the like). Thus, it is the particular appearance of the three-bladed propeller that is non-functional in the '194 Patent design.

In its instruction entitled Description of the Patent, the trial court recited its *Markman* determination. Thereafter, it instructed the Jury that, in order to find infringement, it must find substantial similarity to Petitioner's "design," and proceeded to explain "the devices do not have to be identical." However, the trial court failed to instruct the jury that it was bound by law to apply the "*Markman*" claim construction. By failing to give this instruction, the trial court erred.

The question of whether a jury instruction on an issue of patent law is erroneous is a matter of Federal Circuit law and is reviewed de novo. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). A jury verdict will be set aside, based on erroneous jury instructions, if the movant can establish that

“those instructions were legally erroneous,” and that “the errors had prejudicial effect.” *Id.* at 1281.

Sulzer Textil A.G. v. Picanol, 358 F.3d 1356, 1363 (Fed. Cir. 2004).

The jury must be told that the court has made a claim construction ruling that the jury must follow and cannot be left free to apply its own reading of disputed terms to the facts of the case. “An instruction should be given to the jury on every material issue.” . . . Accordingly, we hold that it is the duty of trial courts in patent cases in which claim construction rulings on disputed claim terms are made prior to trial and followed by the parties during the course of the trial to inform jurors both of the court’s claim construction rulings on all disputed claim terms and of the jury’s obligation to adopt and apply the court’s determined meanings of disputed claim terms to the jury’s deliberations of the facts.

Id. at 1366.

In the present case, the trial court failed to instruct the jury that it was bound to follow the Court’s *Markman* claim construction, allowing the jury free reign in comparing the accused device to Petitioner’s product, as seen in the Jury Interrogatories. As a result, the jury failed to understand the legal issues of design patent claim construction and infringement. In particular, the jury did not understand fully which elements of the ‘194 Patent design were protected. As a result, the jury afforded too much importance to similarities between the unprotected elements of the ‘194

Patent design and Respondents' product, and the jury failed to recognize the significance of the substantial differences in the protected elements (three blades, circular features), all to the obvious prejudice to the Respondents. This error alone was sufficient to mandate a reversal of the jury verdict of patent infringement.

2. The Jury Instructions for Finding Design Patent Infringement Were Flawed.

The Federal Circuit has made it abundantly clear that a finding of design patent infringement must be based on a comparison between the claim of the design patent drawings, as construed by the Judge, and the accused product. *Sun Hill Industries, Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1196-97 (Fed. Cir. 1995). Comparisons between the parties' respective devices are only proper where the patentee's design has no significant design differences from the physical embodiment. *Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1189 (Fed. Cir. 1988).

However, as noted above, in its instruction entitled Description of the Patent, the trial court recited its *Markman* determination and instructed the Jury that, to find infringement, it must find substantial similarity to Petitioner's "design." By itself, this instruction was ambiguous, however, in its Jury Interrogatories, the trial court asked if the jury found "the Wang's/Pilot device [to be] substantially similar to or a colorable imitation of the Hartco device" [emphasis added], and thus violated the clear directive from the Federal Circuit as to the manner in which infringement is to be judged. The comparison made by the jury in the case at bar then necessarily included features common to the respective products, such as the chrome plating of the propeller and the

black coloring of the tapered nose cone, which are not part of the design claimed in the '194 Patent.

This is the jury verdict that Petitioner would have set in stone and insulated from review by the Federal Circuit. As a result of this and other erroneous instructions, the jury failed to understand the legal issues of design patent claim infringement, to the obvious prejudice of the Respondents. This error alone was sufficient to mandate a reversal of the jury verdict of patent infringement. The Federal Circuit took note of the numerous objections urged by Respondents, among other points on appeal, but in light of its finding of non-infringement, it was not compelled to resolve them. Petition Appendix p.10a, n.2.

Thus, it is readily apparent why Petitioner wishes the jury verdict to be insulated from effective review. It was only due to erroneous jury instructions that Petitioner was able to achieve its favorable verdict from the jury.

CONCLUSION

For the foregoing reasons, the Petition for Writ of *Certiorari* to the United States Court of Appeals for the Federal Circuit should be denied.

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**In the
Supreme Court of the United States**

HARTCO ENGINEERING, INC.,

Petitioner,

v.

WANG'S INTERNATIONAL, INC., PILOT AUTOMOTIVE, INC.,
PEP BOYS - MANNY, MOE & JACK, INC.,
AND OVERTON'S, INC.

Respondents.

**On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit**

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

Hartco Engineering, Inc. ("Hartco") hereby responds to the Brief in Opposition filed by Wang's International, Inc., *et al.* ("Wang's").

I. Wang's Contention That the "Questions Presented" Were Not Raised Below Is Both Wrong and Illogical.

From inception, the substance of Hartco's patent case has always been that Wang's device is substantially the same as and a colorable imitation of Hartco's design, *i.e.*, patent infringement under *Gorham Co. v. White*. Responding to Wang's appeal, Hartco's position in the Federal Circuit was that the jury and trial judge found on overwhelming evidence that Wang's product breached the *Gorham* standard and that the Federal Circuit should respect that finding.

Hartco takes exactly the same position in its writ application, but obviously the posture of the case changed when the Federal Circuit rendered its decision reversing the jury and the trial court on the patent infringement claim. Hence, in its writ application, Hartco addresses itself to the action taken by the Federal Circuit. The "Questions Presented" respond to the Federal Circuit decision. Those issues could not have been stated as such until the Federal Circuit rendered its decision.

In effect, Wang's position is that Hartco was required to have complained in advance about the color of the chicken before the chicken was hatched. That position obviously makes no sense.

The cases cited by Wang's are not applicable because in each, the writ applicant could have, but did not, raise the discrete issue in the lower court. Such is not the case here.

Moreover, see *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 698-99, 104 S.Ct. 2694 (1984) (issue not decided below considered on writ where arising from federal court and the substantive issues and relevant facts were treated below). Such is here the case.

II. Wang's Position That, Because the Federal Circuit Did Not Publish its Decision, This Court May Not Consider a Writ Application, Is Clearly Wrong.

In *Commissioner of Internal Revenue v. McCoy*, 484 U.S. 3, 6, 108 S.Ct. 217, 219 (1987), this Court stated:

[T]he fact that the Court of Appeals' order under challenge here is unpublished carries no weight in our decision to review the case. The Court of Appeals exceeded its jurisdiction regardless of nonpublication and regardless of any assumed lack of precedential effect of a ruling that is unpublished.

Certiorari is therefore granted....

That rule applies here.

The Federal Circuit is the sole intermediate appellate court on patent cases. Hence, the patent bar and the lower courts study with great care all Federal Circuit patent opinions, whether published or unpublished. Those decisions, whether published or unpublished, influence district court decisions nationwide and critically impact development of patent law and adjudication of patent cases.

In the case at bar, the Federal Circuit substituted its judgment for that of the jury and the trial court on the pivotal factual issue – – substantial sameness in the eyes of the ordinary purchaser. That issue, substantial sameness in the eye of the ordinary purchaser, is the issue in every design patent case. If the Federal Circuit decision on this case stands, that decision teaches that the jury role in design patent cases is really nonexistent. The Federal Circuit's decision to not publish that opinion cannot shield from review such an important decision of wide applicability.

III. Contrary to Wang's Protestations, the Writ Application Presents Issues of Compelling Importance and Wide Application in Patent Law.

Part III of Wang's brief essentially makes three arguments, *to wit*: (1) that the Federal Circuit decision purportedly does not conflict with *Gorham*, (2) that, under *Markman*, the Federal Circuit may legitimately take from the jury the fact issue of "substantial sameness" and doing so does not violate the Seventh Amendment, and (3) the jury instructions were flawed.

Hartco will respond briefly to each of those themes:

A. While citing *Gorham* as the governing rule, the Federal Circuit has clearly abandoned the essence of the *Gorham* rule both as to scope of design-patent protection and as to the jury's role.

Coupling the *Mann* dogma that design patents have "almost no scope" with *Markman* claim verbalization which focuses on individual features rather than *Gorham*'s focus on

“general appearance and effect,” the Federal Circuit has eroded *Gorham* protection to virtually nothing.

Certainly four blades is different than three blades. Given its current jurisprudence and philosophy, the Federal Circuit effectively ends the discussion at that point – – four is different from three, therefore Hartco loses.¹ But under *Gorham*, the ultimate factual issue is not whether there is a

¹ Wang’s brief (at pp 13-14) also attempts to bolster the Federal Circuit decision by reference to “the four circular features in the tongue portion of the design.”

Wang’s says “petitioner [Hartco] argues that the circular features are simply artifacts of the molding process.” In truth, it is Mr. Wang who concedes that these “circular features” are merely a residue of the molding process, not visible when the device is in place and they are not ornamental in any respect. (Transcript, pp. 269-271); *also*: Hartco Writ Application at 42a).

As to Wang’s argument that these features are ornamental because required by the Patent Office, again Wang’s ignores the sole evidence on that point. The patent examiner simply stated regarding the drawings “correction for consistency is required.... [I]n Fig. 3, the four circular features located in the interior corners of the hitch cover must be enlarged to match their relative size as shown in as-filed Fig. 3.” That is the only Patent Office reference to these so-called “features.” (Defense Exh. “File History” of “194 Patent, Federal Circuit appendix 0393, attached hereto as 1b).

That such a non-consequential reference to “circular features” is made in the patent file does not make those “features” material, particularly when the patent file itself shows the complete immateriality of the reference. *See: Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.*, 520 U.S. 17, 33, 117 S.Ct. 1040, 1051 (1997).

difference, but whether the difference is substantial in the eye of the ordinary purchaser. Moreover, under *Gorham*, this is a jury issue.

There is no real “substantial evidence” issue in this case. All of the evidence at trial showed actual confusion in the marketplace with retailers unknowingly substituting Wang’s product for Hartco’s and even using Hartco’s advertising literature to sell Wang’s product. There was no lack of substantial evidence to prove Hartco’s case. Plainly and simply, the Federal Circuit disagreed with the six “ordinary purchasers” on the jury and substituted the Federal Circuit’s factual determination for that of the jury. Having done so, the Federal Circuit’s decision clearly conflicts with *Gorham*.

B. If, as it does, the Seventh Amendment preserves the right of trial by jury in a design-patent case, then the question of “substantial sameness in the eyes of the ordinary purchaser” is clearly a jury issue. There was no legitimate basis for the Federal Circuit to have taken that issue from the jury and thereby deprive Hartco of its Seventh Amendment right.

In its brief, Wang’s states that this case presents “a set of uncontested facts.”² As to the underlying objective facts, Hartco agrees. The uncontested material facts presented by Hartco and not disputed by Wang’s are:

² Wang’s Brief in Opposition, pg. 11.

1. Wang's copied the Hartco design, product and packaging as closely as Wang's could but simply adding a fourth blade to create an argument for non-infringement.
2. Wang's product directly competed with Hartco's product and took numerous customers directly from Hartco.
3. Wang's product caused confusion in the marketplace with some retailers unknowingly substituting the Wang's product for the Hartco product and even using Hartco's literature to sell the Wang's product.

The only really contested issue is whether the undeniable similarity between Wang's product and Hartco's design constituted a substantial difference in the eyes of the ordinary purchaser or whether, as stated, in *Gorham*, the fourth blade was merely a "minor difference in detail ... not noticed by ordinary observers" and added merely to avoid "condemnation as an infringement."³ In sum, the issue is whether "substantial sameness in the eye of the ordinary purchaser" is a jury issue or a legal issue. It is clearly not a "lack of substantial evidence" issue (as erroneously characterized by the Federal Circuit) because the evidence presented by Hartco was not only substantial, but uncontested.

We respectfully submit that if the Seventh Amendment is to have any meaning in a design-patent case, then "substantial sameness ..." is of necessity a jury issue on which Hartco unequivocally prevailed.

³ *Gorham*, 81 U.S. at 528.

Conceptually, we might conclude that there are two general categories of fact finding:

1. *Objective fact finding* -- Was the traffic light red or green? Was the defendant the masked man who robbed the bank?
2. *Subjective or evaluative fact-finding* -- Did the defendant exercise reasonable care? Did the defendant have specific intent to cause death or great bodily harm? Was the product reasonably fit for its intended purpose? Was the Wang's product substantially the same as Hartco's "in the eye of an ordinary observer, giving such attention as a purchaser usually gives" to such matter.

The Seventh Amendment entrusts both objective fact finding and evaluative fact finding to the jury. "Substantial sameness in the eye of the ordinary observer" is really the only central liability fact issue in every design-patent case. The Seventh Amendment clearly mandates referral of that issue to the jury.⁴

C. The jury instructions properly presented to the jury the applicable law, the trial court's *Markman* construction, and a correct statement of the jury's function.

The jury instructions included verbatim the *Markman* construction requested by Wang's. The trial judge correctly instructed the jury in the *Gorham* rule and its function in

⁴ For further discussion as to why this type of issue must go to the jury, please see Hartco's original brief at pp. 23-28.

determining whether or not there was substantial sameness in the eye of the ordinary observer.

Wang's complains that the trial judge did not specifically tell the jury that it was legally required to follow the court's *Markman* construction. In other words, according to Wang's, since the trial judge described Wang's product as having four blades, the trial judge should have instructed the jury that anything other than four-blade propeller could not be an infringement. Wang's is clearly wrong. If *Gorham's* "substantial sameness" rule is to have any life, then the proper procedure is exactly what Judge Lemelle did in this case. The trial judge verbalizes a construction and he then leaves it up to the jury to determine whether there is substantial sameness in the eyes of the ordinary observer.

As to the jury interrogatory, Wang's now complains that the interrogatory referred to Hartco's device as opposed to Hartco's design. But the record is clear that Wang's made no such complaint during the jury charge conference or at any time prior to submission to the jury.⁵ Wang's cannot now complain about a point that it did not even raise at trial.

⁵ The relevant part of the jury charge conference is as follows:

The Court: Defendant, jury form.

Mr. Weseman: The only point I have is in jury interrogatory No. 1, the validity of a patent is actually a distinct question from the enforceability of the patent. And so, I would prefer that we add after valid, and enforceable.

The Court: I think that is inherent, I think it covers it.
What else?

Mr. Weseman: That's it for us, Your Honor.

Transcript, pg. 392.